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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,354

10/20/2005

Martin Quibell

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9132

29933 7590 04/16/2007

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EXAMINER

HAVLIN, ROBERT H

ART UNIT

PAPER NUMBER

1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

04/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/521,354

Applicant(s)

QUIBELL ET AL.

Examiner

Robert Havlin

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31,33,35,37-39,41,43-45,47,49-52,58 and 60-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-31,33,35,37-39,41,43-45,47,49-52,58 and 60-74.

### DETAILED ACTION

Claims 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74 are currently pending.

### *Election/Restrictions*

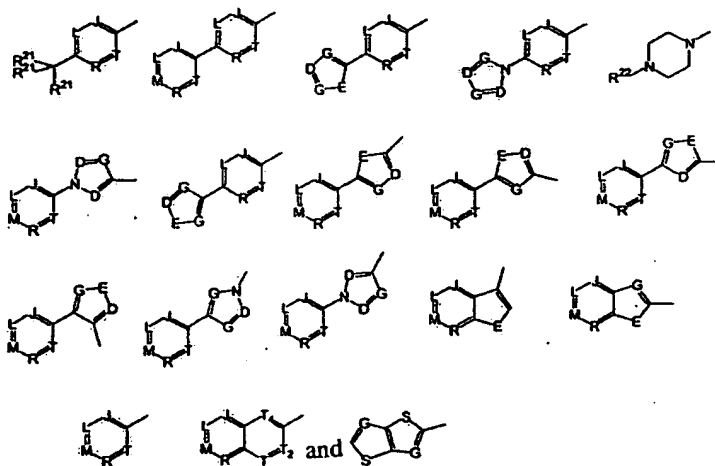
1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

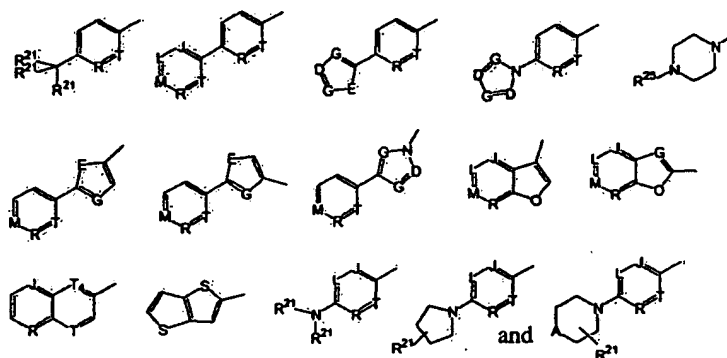
For the purposes of defining chemical groups:

A1 is one of the following:

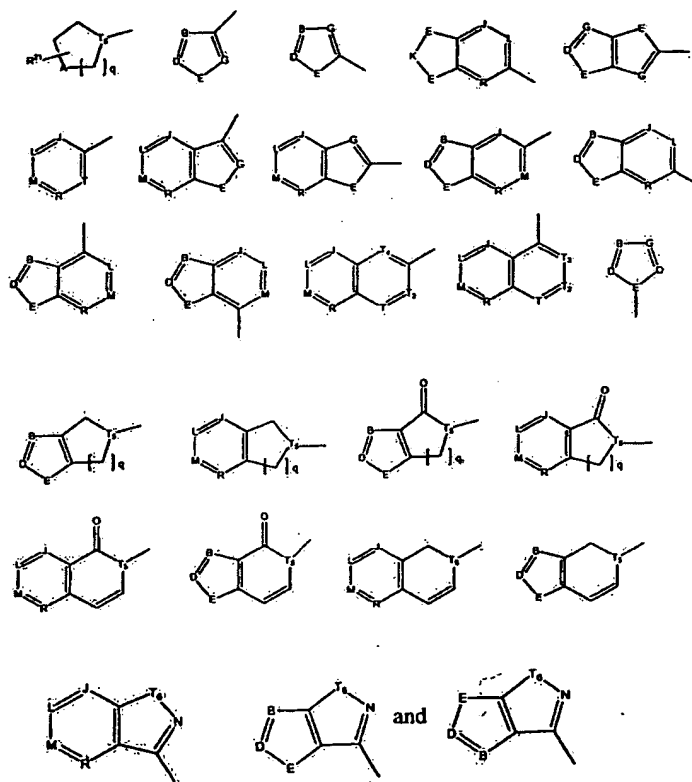


A2 is one of the following:

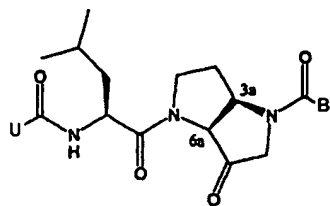
Art Unit: 1609



A3 is one of the following:

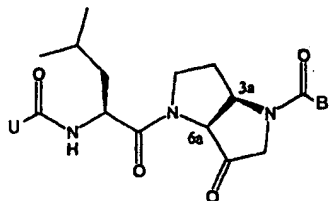


Group I, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula



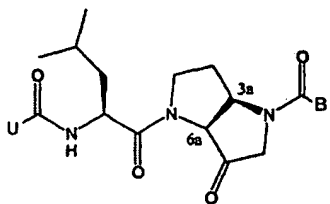
, wherein U is only one of A1 and B does not contain any heterocyclic groups.

Group II, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula



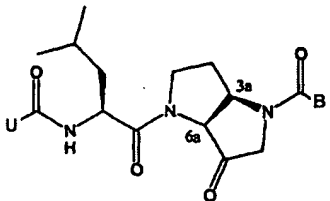
, wherein U is only one of A2 and B does not contain any heterocyclic groups and is not encompassed by any of the possible compounds of group I.

Group III, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula



, wherein U is only one of A3 and B does not contain any heterocyclic groups and is not encompassed by any of the possible compounds of group I or II.

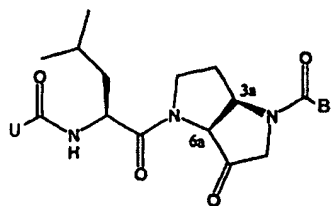
Group IV, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula



, wherein U is only one of A1 and B contains heterocyclic groups and is not encompassed by any of the possible compounds of group I-III.

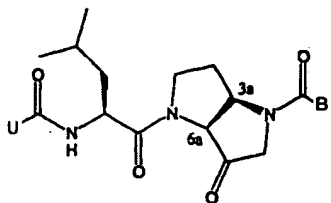
Group V, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula

Art Unit: 1609



, wherein U is only one of A2 and B contains heterocyclic groups and is not encompassed by any of the possible compounds of group I-IV.

Group VI, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use with the core formula



, wherein U is only one of A3 and B contains heterocyclic groups and is not encompassed by any of the possible compounds of group I-V.

Group VII, claim(s) 1-31, 33, 35, 37-39, 41, 43-45, 47, 49-52, 58, 60-74, in part, drawn to a compound, composition, and method of use claimed but not encompassed in any of the above groups. Election of this group may be subject to further restriction.

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the compounds of the various Groups clearly have different structural features so as to be chemically non-equivalent. There is no contribution over the prior art and also no structural similarity between the various Groups so as to define a contribution over the prior art. The various P1, P2, Z, U, Y, R1, and substituents vary extensively and when taken as a whole result in vastly different compounds. The only common element in the various Groups is the N-C-C=O linkage in the ring system of formula (I). Accordingly, unity of invention is considered to be lacking and a restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Moreover, the vastness of the claimed subject matter, and the examination of the various forms impose an undue burden on the examination of the entire application.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Havlin whose telephone number is (571) 272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Cecilia Tsang can be reached at (571)-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert Havlin  
Examiner

RH



**VICKIE KIM**  
**PRIMARY EXAMINER**